

REMARKS

In the July 14, 2004 Final Office Action, claims 1-4, 6-7, 12-16, 21, 25, 30-33 and 35-36 have been rejected as obvious over U.S. Patent No. 5,324,922 to Roberts (“the ‘922 patent”) in view of Patent No. 6,308,893 to Waxelbaum (“the ‘893 patent”) under 35 U.S.C. §103(a). The ‘922 patent generally teaches a system for managing transactions that uses a barcode reader connected to a transaction terminal to read barcodes from a specialized catalog. The ‘893 patent generally teaches a compact optical code reader capable of performing functions including reading bar codes for use in sales transactions. The rejected claims have either been canceled or amended herein in order to more clearly reflect patentable aspects of the present invention, to place the claims in a condition suitable for allowance, and/or to better frame issues for appeal.

Claim 1 has been amended to include the limitations of claim 4, which has been canceled, as well as additional limitations. As amended, claim 1 recites limitations not taught or suggested by the ‘922 or ‘893 patents, and is therefore allowable. For example, amended claim 1 recites a method for automated shopping including the steps of using a handheld wand that comprises an elongated device extending between first and second distal ends and configured to be held in a hand. Claim 1 further recites steps of activating a user mode button, a vendor mode button, and a product mode button located on the wand between the distal ends. Neither of the ‘922 or ‘893 patents disclose these steps or this wand structure.

In his rejection of previous claim 4, the examiner has suggested that the ‘922 patent discloses such a structure in that the FIG. 1 of the ‘922 patent shows a wand 21 connected by a flexible cord to a transaction terminal 10 with keyboard 11. It will be appreciated, however, that the wand 21 is therefore clearly not “cordless” as recited. See, e.g., ‘922 patent FIG. 1. Further, the keys on the keyboard 11 are clearly not located on a handheld cordless wand as recited in claim 1, but are instead taught to be on the flat keyboard 11 connected to the wand 21 by a flexible cord. Id.

It is also noted that the '922 patent fails to teach placing the handheld wand in a user mode by activating a user mode button on the handheld wand and reading a user identity code with the handheld scanning wand as is recited by claim 1. The examiner has suggested that this limitation is met by the teaching of the '922 patent that a user credit card be swiped through a card reader 18A. It is submitted, however, that swiping a card through a card reader as taught by the '922 patent does not meet claim 1's recited limitations of activating a user mode button located on a handheld cordless wand. The card reader 18 and requirement that a user have a credit card for swiping as taught by the '922 patent represents added complexity, effort, time and cost as compared to the method of claim 1.

Claims 4-11 and 15-20 have been canceled. Claims 2, 3, 12, 14, and 21 depend from claim 1 and are allowable for the same reasons as are claim 1 in addition to other reasons. For example, claim 3 recites extracting a first and a second vendor identity code from the transaction file and communicating at least a portion of the transaction file to each of the first and second vendors. Neither of the '922 or '893 patents discloses multiple vendors being identified in a single transaction file.

Claim 12 depends from claim 1 and further recites vendor mode, user mode, and product mode indicator lights on the elongated handheld rigid cordless wand, each of the lights being proximate to the respective mode button. Claim 12 also recites that each of the respective lights are separate from one another. Neither of the '922 nor the '893 patents disclose these limitations. Although the examiner has suggested that the display 12A of the '922 patent comprises an "indicator," it is submitted that the display 12A is only one display, and not three separate indicator lights as recited. Further, it is submitted that the display 12A is not located on a cordless handheld scanning wand as recited, but is instead on a flat keyboard.

Independent claim 25 has been amended to make clear that the vendor mode, user mode, product mode, and order status mode switches are located between distal ends of a handheld wand. Claim 25 as amended also recites indicator lights for

each of said user mode, vendor mode, product mode and order modes that are located proximate to respective of the switched on the wand. As discussed above, neither of the '922 or the '893 patents disclose or suggest these limitations.

Independent claim 30 directed to a computer program product has been amended to make clear that vendor mode, user mode, and product mode buttons are located between the distal ends of a rigid, elongate cordless handheld scanning wand. As discussed above, neither of the '922 nor the '893 patents disclose or suggest these elements. Claim 30 has also been amended to make clear that these respective switches are manually activated. This is also not taught by the '922 and '893 patents. Although the examiner has argued that scanning of a barcode as taught by the '922 patent discloses placing the device in a particular mode, it will be appreciated that scanning of a barcode cannot meet the recited manual activation of a switch. Claim 30 also recites that manual activation of the switches located on the wand causes an indicator light proximate to the respective switch to be illuminated. None of the cited references teaches this.

Claim 31 has been canceled. New claims 32-36 depend from claim 1 and are allowable for the same reasons as are that claim in addition to other reasons. Claims 32-35 recite reading various parts of a catalog, including a mailing label, a catalog title, and an alpha-numeric product code. Neither of the '922 or '893 patents discloses these limitations, but instead require specially prepared documents with bar codes to be read. Although the examiner has suggested in the Final Office Action that claim 34 is obvious over the '922 and '893 patents in view of a third reference that teaches character recognition, it is submitted that this is an improper rejection in that the third reference would not motivate one knowledgeable in the art to combine it with the '922 and '893 patents. To cite these three references in combination is to impermissibly view the prior art only in hindsight after the beneficial consideration of the present invention.

Claim 36 recites steps of ordering two different products from two different vendors in a single transaction file, and of an order center processing the transaction file by communicating with two different vendors. Neither of the '922 or the '893 patents

disclose these steps, but instead contemplate communication with only a single end destination.

The above amendments and remarks have placed the claims in a condition suitable for allowance, or, in the alternative, have more clearly framed issues for an appeal. As such, these amendments should be entered. Timely allowance is requested. If the examiner feels that there are issues that may be resolved by a phone conference, the applicant's undersigned attorney requests that he be contacted to attend to these issues.

Respectfully submitted,

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